

REMARKS

Claims 61-100 were pending when the present Office Action was mailed January 9, 2008. In this response, claims 70, 71 and 73 have been amended. Claim 72 has been cancelled without prejudice. No new matter has been added by way of these amendments. Accordingly, claims 61-71 and 73-100 are currently pending.

In the January 9, 2008 Office Action, claims 70, 71, 73-78 and 96-100 were rejected, and the rest of the pending claims were allowed or indicated as being allowable if rewritten in independent form. More specifically, the status of the application in light of this Office Action is as follows:

1. Claims 70 and 73 were subject to an objection as being drawn to compounds in the context of a product-by-process claim format;
2. Claims 70 and 73 were rejected under 35 U.S.C. § 102(b) over European Patent No. 246,366 to White et al. ("White");
3. Claims 70, 73-78 and 96-100 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting to co-pending U.S. Application No. 10/750,457;
4. Claims 71 and 73 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,696,911 to Boerma ("Boerma");
4. Claims 72, 79-81 and 90-93 were indicated as being allowable; and
5. Claims 61-69, 82-89, 94 and 95 were allowed.

I. Amendments to the Claims

Claim 70 has been amended to remove the objected product-by-process claim format;

Claim 71 has been amended to include the features of allowable claim 72;

Claim 72 has been cancelled; and

Claim 73 has been amended to remove the objected product-by-process claim format and to depend from claim 70.

No new matter has been added by way of these amendments.

II. Product-by-Process Claim Objections

Claims 70 and 73 were objected to as being drawn to compounds in the context of a product-by-process claim format. In this amendment, claims 70 and 73 have been amended to remove the objected product-by-process claim format. Claim 70, as amended, includes features of allowable claim 61; and Claim 73, as amended, depends from claim 70.

Accordingly, Applicants respectfully request that the objection to claim 79 be withdrawn.

III. Rejection Under 35 U.S.C. 102

Claims 70 and 73 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by White.

These rejections are respectfully traversed for the following reasons.

A. The Present Claims

Amended claim 70 is directed to an edible fat composition comprising a partially hydrogenated fat. The partially hydrogenated fat has a solid fat content of about 20-80 weight percent at 20°C and a trans-fatty acid content of no greater than about 15 weight percent of a fatty acid profile. The partially hydrogenated fat also has an average Iodine Value change rate of no less than about 5/hour, wherein the average Iodine Value change rate is defined by the absolute difference between an initial Iodine Value of the fat prior to hydrogenation and a modified Iodine Value of the fat following hydrogenation divided by a hydrogenation time.

B. The Applied Art

WHITE is directed to a process of hydrogenating liquid oils to provide a hydrogenated oil having a narrow melting range but relatively stable, e.g., more solid than liquid at room temperature (21°C - 33°C) (pg. 3, ln. 15, 29-30, 36-37). White's process includes hydrogenation of the liquid oil with a partially deactivated nickel catalyst at a hydrogenation temperature that starts between 160°C and 200°C and which gradually increases to a final temperature of 210°C to about 250°C. The preferential temperature range taught by White is about 180°C to about 240°C (pg. 3, ln. 21-26; pg. 5, ln. 23-25). White relies on using a partially deactivated nickel catalyst, preferably a sulfur-poisoned deactivated nickel catalyst, to

"control the rate of the reaction, and thereby the relative proportions of *cis*- and *trans*-fatty acid triglycerides in the products formed" (pg. 4, ln. 40-43).

C. Analysis

The standard for lack of novelty, that is, for anticipation, is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. M.P.E.P. § 2131.

White fails to support a *prima facie* case for rejecting claim 70 under Section 102 for at least the reason that this reference fails to disclose or suggest several claimed features. For example, claim 1 requires a *trans*-fatty acid content of no greater than about 15 weight percent of a fatty acid profile. This feature is not shown or suggested by White.

In contrast to the Applicants' claimed features, White does not teach or suggest a partially hydrogenated fat having a *trans*-fatty acid content of no greater than about 15 weight percent of a fatty acid profile. In fact, White teaches using a hydrogenation temperature consistent with the higher temperatures of the prior art such that the combined effect of using higher temperatures during the hydrogenation process and a partially deactivated nickel catalyst results in hydrogenated fat products that are more solid than liquid at room temperature and have a *trans*-fatty acid content ranging from 41% to 64% of the modified fatty acid composition (White; pg 7-9, Examples 1-3). More specifically, White discloses that "as the temperature of reaction is increased, the formation of *trans*-unsaturation increases almost linearly" (White; pg. 3, ln. 54-55). Accordingly, the edible fat composition of claim 70 is different from the hydrogenated product produced from the process of White because White uses a higher temperature during hydrogenation that produces a higher *trans*-fatty content than the partially hydrogenated fat of claim 70. As such, White fails to meet the requirement for anticipation for at least this reason, and the Section 102 rejection should be withdrawn.

Claim 70 is also patentable over White because White teaches away from further reduction in *trans*-fatty acid content. White discloses that the relative proportion of *cis*- and *trans*-fatty acid triglycerides is critical to the desired melting properties of the composition.

White also teaches that relatively equal levels of cis- and trans-fatty acids yield a mixture of solids (trans-fatty acids) and liquids (cis-fatty acids) that have desirable stability at room temperature as well as desirable melting properties at higher body temperatures. (White; pg. 4, ln. 11-12, 40-42). By specifically teaching the advantages of using a partially deactivated nickel catalyst and higher hydrogenation temperatures, White teaches away from the features of claim 70. Accordingly, Applicants submit that claim 70 is patentable over White and respectfully request that the Section 102 rejection of this claim be withdrawn.

Claim 73 depends from claim 70. Thus, this claim should not be rejected under Section 102 over White for the reasons discussed above and for the additional features of this claim.

IV. Obvious-type Double Patenting Rejection

Claims 70, 73-78 and 96-100 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 28-30, 37, 39-40 and 57-67 of co-pending U.S. Application No. 10/750,457. The Examiner noted that a timely filed Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) or 1.321(d) would overcome an actual or provisional rejection on this ground.

Without conceding to the merits of this rejection, and in the interest of expediting prosecution of the present application, Applicants submit herewith an executed Terminal Disclaimer filed in accordance with 37 C.F.R. §1.321(c) which disclaims the terminal portion of any patent issuing on the instant application that extends beyond the expiration of any patent that issues from U.S. Patent Application No. 10/750,457.

The Applicants submit that Terminal Disclaimer overcomes the rejection for obviousness-type double patenting with respect to claims 70, 73-78 and 96-100, and withdrawal of the rejection with respect to these documents is respectfully requested.

V. Rejection Under 35 U.S.C. 103

Claims 71 and 73 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Boerma.

Without commenting on or conceding to the Examiner's rejection of claim 71, Applicants have amended this claim to include the features of allowable claim 72. Thus, amended claim

71 is now allowable. Claim 73 has been amended to depend from amended claim 70, and as discussed above, is also allowable. Accordingly, Applicants respectfully request that the Section 103 rejection of claims 71 and 73 be withdrawn.

VI. Allowable Subject Matter

A. Response to Claim Objection

Claims 72, 79-81 and 90-93 are objected to as being dependent upon a rejected base claim. As noted above, Claim 71 has been amended to include the features of allowable claim 72, and claim 72 has been canceled. Also, a Terminal Disclaimer with respect to U.S. Patent Application No. 10/750,457 is enclosed with this paper, and accordingly, claim 74 is allowable. As such, claims 79-81 and 90-93 are also allowable.

B. Allowed Claims

The Applicants would like to thank the Examiner for allowing claims 61-69, 82-89, 94 and 95. As such, these claims have not been amended in this response.

VII. Conclusion


Reconsideration and withdrawal of the rejections set forth in the Office Action dated January 9, 2008 are respectfully requested.

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. A Notice of Allowance is, therefore, respectfully requested. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned representative at (206) 359-8118.

Payment of the 3-month extension of time petition fee is submitted via EFT Account No. SEA1PIRM. If any additional fee is due, please charge our Deposit Account No. 50-0665, under Order No. 334498010US1 from which the undersigned is authorized to draw.

Respectfully submitted,
Perkins Coie LLP

Date: July 7, 2008


Kellie S. Bickel
Registration No. 46,386

Correspondence Address:

Customer No. 25096
Perkins Coie LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 359-8000